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EXAMINER

AMIRI, NAHID

ART UNIT PAPER NUMBER

3679

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/824,213

Applicant(s)

DURHAM, CHRISTOPHER W.

Examiner

Nahid Amiri

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 8 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>exhibit</u> .                          |

## **DETAILED ACTION**

### **Response to Amendment**

In view of Applicant's Amendment received 23 December 2005, amendments to the claims have been entered. Claims 1-16 are pending.

### ***Drawings***

The drawings were received on 23 December 2005. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said base" in line 14. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3, 7, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,802,519 B2 Morgan et al.**

In regard to claim 1: Morgan et al. disclose a fork clamp (Figs. 1, 2) comprising an elongated body (13) having a pair of spaced fork leg receiving openings (P and P') (see attachment), and defining an opening (P'') (see attachment) disposed generally between said fork receiving openings (P and P') for receiving a steering shaft, a pair of spaced handlebar mounts (14) disposed on opposite sides of the steering shaft opening (P''); the spaced handlebar mounts each being disposed between a the fork receiving openings (p and P') and said steering shaft opening (P''), and a generally flat vibration dampening (18) insert interposed between the body (13) and the handlebar mounts (14).

In regard to claim 3: Morgan et al. disclose (Fig. 1) the handlebar mount (14) each having a base secured to the body (13) and a cap (17) secured to the base to define a handlebar receiving passageway therebetween.

In regard to claim 7: Morgan et al. disclose (Fig. 1) the body (13) having a cavity (19) within which the vibration dampening insert (18) is received.

In regard to claim 14: Morgan et al. disclose a clamp (13) being a triple motorcycle clamp, and the vibration dampening insert (18) substantially completely underlying the handlebar mounts (14).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al., as applied to claims 1, 3, 7, and 14 above, and further in view of US Patent No. 5,921,145 Muser.**

In regard to claims 2 and 10: Morgan et al., disclose the claimed invention except vibration damper insert being resiliently compressible and consisting of rubber and resinous polymer. Muser teaches (Fig. 1) (column 3, lines 6-8) the damper (80) is formed from resilient material such as polyurethane, which inherently includes the rubber, and resinous polymer material. It would have been obvious to one of ordinary skill in the art at the time of invention was made to form the damper insert of Morgan consisting of rubber and resinous polymer as taught by Muser in order to construct a resilient and flexible damper insert.

**Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al., as applied to claims 1, 3, 7, and 14 above, and further in view of US Patent No. 6,035,741 Krizman, Jr.**

In regard to claim 11: Morgan et al. disclose the claimed invention except being silent in regard to type of material handlebar mount made of. Krizman teaches (Fig. 1, column 4, lines 29-30) the handlebar mounts (14 and 15) made of metal. It would have been obvious to one of ordinary skill in the art at the time of invention was made to form the handlebar mounts of Morgan et al. from metal as taught by Krizman in order to secure a larger diameter handlebar to a motorcycle or comparable vehicles.

**Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al.**

In regard to claim 12: Morgan et al. disclose the claimed invention (Fig. 2) shows that each C-shaped fork leg receiving openings (P and P') having a line is going through it and bolt being connect two sides of C-shaped together. Even though Morgan silent in regard to adjustability of receiving opening, but It would have been obvious to one of ordinary skill in the art to loosen the bolt in order to enlarge the receiving opening for catching lager size fork tube.

In regard to claim 13: Morgan et al. disclose the claimed invention except for steering shaft opening being of adjustable size. It would have been obvious to one of ordinary skill in the art to modify the shaft opening of Morgan et al. to have close C-shaped such as receiving openings (P and P') with a line is going through it and by loosen the bolt being connect two sides of C-shaped together in order to enlarge the shaft opening for receiving different size shaft.

***Allowable Subject Matter***

Claims 4-6 and 16 stand allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 8, the prior art of record does not show or suggest the vibration dampening insert being generally U-shaped. With respect to claim 15 the vibration dampening insert substantially completely underlying the handlebar mounts. Morgan et al. only teach (Fig.2) a hydraulic dampening (18) with door lock-shaped configuration which located between a pair of handlebar mounts (14) and a pair of spaced fork leg receiving openings (P and P'), and there is no reason to combine the either Muser '145 or Krizman '741 with Morgan et al. '519.

***Response to Arguments***

Applicant's arguments filed 23 December 2005 have been fully considered but they are not persuasive.

Applicant's arguments, filed 23 December 2005, with respect to claims 8 and 15 have been fully considered and are persuasive. The rejection of claims 8 and 15 has been overcome.

In regard to claims 1, 3, 7, and 14, Applicant argues with respect to claim 1, that Morgan et al. '519 teach a damper 18 comprising a complex hydraulic assembly which interacts with steering stem 11 to dampen the rotational movement of the steering system, and handlebars 15 are held by riser posts 14 which connect directly to fork clamp 13, while the dampening insert 130 of applicants' invention is flat and interposed between the body 72 and the handlebar mount 110, 112, and the insert underlying the base 114 of the respective handlebar mounts 110, 112.

With respect to claim 3, the single clamp plate 17 of Morgan et al. '519 does not teach nor suggest the handlebar mount each having a base secured to the body and cap secured to the base. With respect to claim 7, Morgan et al. do not teach or suggest that the dampening insert is generally flat and further suggest the recital of a cavity for receiving such insert. With respect to claims 2 and 10, the damper 80 located between the handlebar and the handlebar mount as taught by Muser '145 is not flat. Therefore, it would not have been obvious to make the damper of Morgan et al. of rubber as taught by Muser '145, since these are nonanalogous arts. Examiner disagrees.

With respect to claims 1, 3, 7, and 14, Morgan et al. '519 teach a clamp assembly (Fig. 2) having a flat damper 18 and body having a recess (19) for receiving a damper 18, having a risers as handlebar mounts (14) each having a base secured to the body (13) and a cap (17) secured to the base. With respect to claim 2, Morgan et al. '519 and Muser '145 are nonanalogous art because it has been held that a prior art reference that is either in the field of applicant's endeavor or, if not, then reasonably pertinent to the particular problem with which the applicant was concerned, can be relied upon as a basis for rejection of the claimed invention. *See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992)*. In this case, applicant's field of endeavor is a clamping assembly per se.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya, 184 USPQ 607 (CCPA 1975)*. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin, 170 USPQ 209 (CCPA 1971)*. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek, 163 USPQ 545 (CCPA) 1969*.


*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nahid Amiri whose telephone number is (571) 272-8113. The examiner can normally be reached on 8:30-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nahid Amiri  
Examiner  
Art Unit 3679  
February 27, 2006



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